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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: **Gavin BREBNER et al.**) Examiner: David E. ENGLAND
Serial No.: **09/881,211**)
Filed: June 14, 2001) Art Unit: 2143
For: "DEVICE AND METHOD FOR) Our Ref: B-4213 618881
OUTPUTTING LOCATION) 50003785-1 US
INFORMATION") Date: July 19, 2006
) Re: *Appeal to the Board of Appeals*

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from the Final rejection, dated December 16, 2005, for the above identified patent application. This Appeal Brief is being timely filed in reply to the Notification of Non-Compliant Appeal Brief mailed on October 20, 2006, a response to which is initially due by November 20, 2006, and is intended to replace the Appeal Brief previously submitted on July 19, 2006 in support of the Notice of Appeal filed on May 16, 2006. If required, please deduct the amount of \$500.00 for the fee set forth in 37 C.F.R. 1.17(c) for submitting this Brief from deposit account no. 08-2025.

REAL PARTY IN INTEREST

The real party in interest to the present application is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

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RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the present application.

STATUS OF CLAIMS

Claims 1-19 are the subject of this Appeal and are reproduced in the accompanying appendix.

STATUS OF AMENDMENTS

No Amendment After Final Rejection has been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention claimed in claim 1 is directed to a hard-copy output device, comprising a memory for storing location data (p. 4 l. 19), a network interface (p. 4 ll. 23-24), and an HTTP location server for receiving and storing location data in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory (p. 4 ll. 20-25).

The invention claimed in claim 3 is directed to a hard-copy output device comprising a wireless interface for receiving data (p. 4 l. 8), a memory (p. 4 l. 19), a network interface (p. 4 ll. 23-24), and a location server for receiving location data via the wireless interface and storing it in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory (p. 4 ll. 20-25).

The invention claimed in claim 11 is directed to a hard-copy output device comprising a memory (p. 4 l. 19), and a location server for receiving location data and storing it in said memory and for accessing the stored location data and outputting it, the location server being operative to convert the location data it handles between a first form and a second form, one of the first and second forms being a semantic location form and the other a form based on geographic coordinates (p. 4 ll. 6-25).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Issue 1: Whether claim 9 is indefinite under 35 U.S.C. 112.

Issue 2: Whether claims 1-19 are unpatentable under 35 U.S.C. 103(a) over U.S. Pat. No. 6,748,426 to Shaffer et al. in view of U.S. Pat. No. 6,738,841 to Wolff.

Appellants note that for each ground of rejection which Appellants contest herein and which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

ARGUMENT

Issue 1: Whether claim 9 is indefinite under 35 U.S.C. 112.

In section 3 of the final Office Action of December 16, 2005, the Examiner rejects claim 9 under 35 U.S.C. 112 as being indefinite for reciting “the related reliability indicator.” Appellants respectfully disagreed and explained in their immediately preceding submission that claim 9 depends from claim 8, which recites that the received location data includes a reliability indicator which the location server uses to determine whether or not to overwrite existing location data. Appellants thus submitted to the Examiner that it is clear and definite that “the related reliability indicator” in claim 9 refers to the reliability indicator included in the received location data as recited in claim 8 and that no other interpretation is possible. The Examiner does not address this rejection in the Advisory Action of April 18. Appellants can thus only surmise that the rejection is maintained and therefore respectfully request the Board to overturn this rejection on appeal for the reasons set forth above.

Issue 2: Whether claims 1-19 are unpatentable under 35 U.S.C. 103(a) over U.S. Pat. No. 6,748,426 to Shaffer et al. in view of U.S. Pat. No. 6,738,841 to Wolff.

In section n6 of the final Action, the Examiner rejects claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,748,426 to Shaffer et al. in view of U.S. Pat. No. 6,738,841 to Wolff. In particular, the Examiner finds that Shaffer teaches a memory, a network interface, and a location server all having the claimed attributes at, according to the Examiner, column 5, line 31 to column 6, line 2. The Examiner admits that Shaffer does not teach a wireless interface for receiving data, but further finds that Wolff teaches a wireless

interface and a location server, as claimed, at column 8, lines 48-68. The Examiner finally opines that it would have been obvious to the skilled person to combine Shaffer and Wolff because “utilizing a wireless link to a printer gives a user the mobility to transmit and/or print data in any area that the printer and/or printer server can accommodate.”

In their last submission, Appellants explained why they are compelled to disagree with the Examiner’s understanding of these references. Specifically, and contrary to the Examiner’s understanding, Shaffer does not in fact teach a hard-copy output device comprising a location server for receiving and storing location data in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory. The disclosure at column 5, line 31 to column 6, line 2 of Shaffer that is cited by the Examiner discusses a “Linkage Key” which “is a data value used to associate in real-time information located in multiple databases or network nodes” and can be “DPC, ZIP+4, State-county/census tract/census block, coordinate interleaved pair (lat/lon) or quad-tree, 10-digit telephone number, standardized street address, standardized street address plus a standardized name, 10-digit telephone number plus standardized name, sequentially assigned number, and the like.” This portion further discusses a client computer sending a client’s current location and receiving, through the Linkage Key and a Linkage Mechanism, information regarding the client’s current location (such as near-by stores).

As most easily understood with reference to Fig. 2 of Shaffer, the system of Shaffer “includes a Linkage Key application server 30, a United States Postal Service address translation server 32, a map server 34, a web server 36, an ACD server 38 and a voice recognition server 40.” Col. 11, ll. 33-37. All of these components are required to provide the functionality of Shaffer, and not one of them is a hard-copy output device. Furthermore, not one of them offers, by itself, the claimed functionality of the present invention, i.e. receiving and storing location data in the memory and responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory. In Shaffer, location data is stored over several components – the map server and ACD server at a minimum. Client requests are responded to by the web server. Location information is derived from “local and external databases” (col. 11 l. 44) by the Linkage Key application server. And again, there is no hard-copy output device.

Regarding Wolff, Appellants respectfully disagreed with the Examiner's opinion that the skilled person would be motivated to attempt to combine it with Shaffer and, even more importantly, that doing so would result in anything akin to the claimed invention. Wolff teaches connecting a printer to a network. Thus, applying the teaching of Wolff to Shaffer would only result in yet one more component, a printer, being added to the system of Shaffer. There is nothing in Shaffer or Wolff that would motivate the skilled person to endow the printer of Wolff with a location server for receiving and storing location data in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory. Why do so when the system already includes a Linkage Key application server, a United States Postal Service address translation server, a map server, a web server, an ACD server and a voice recognition server?

In the Advisory Action, the Examiner dismisses Appellants' arguments by conveniently refusing to accord any patentable weight to the claims' recitation of a hard-copy output device, invoking the oft-quoted proposition that a "preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." As a cursory read of the claims will quickly inform, they meet neither of these requirements. The preamble of all claims recites "a hard-copy output device." This is clearly not a recitation of a purpose nor an intended use; rather, it is the very device of the invention itself. Furthermore, the Examiner has made no showing that the structural limitations of the claims are able to stand alone. What, for instance, do the following structural elements, without the preamble, disclose to the skilled person: a memory, a network interface, and an HTTP location server? Appellants submit that the Examiner's refusal to accord patentable weight to the preamble of the present claims is completely misguided and an improper application of the case law, as explained in detail immediately above.

The Examiner further offers in the Advisory Action, with respect to Appellants' discussion of the failure of Shaffer to teach a hard-copy output device comprising a location server for receiving and storing location data in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the

location data stored in memory, "that it say 'comprising "OR" derived from' giving the claim limitations a broader meaning. All that is claimed is location information that is stored in memory that is requested from a client...." The Examiner apparently completely misses the thrust of Appellants' argument, namely that Shaffer does not teach a hard-copy output device, nor any one device for that matter, that RETURNS such location information from data stored in ITS OWN MEMORY in response to client requests. As explained above, Shaffer teaches a distributed system that (1) does not include a hard-copy output device, and (2) does not include a device that includes all of the claimed limitations, including storing and returning the claimed location information.

With respect to Appellants' argument that there is absolutely no motivation nor expectation of success for the asserted combination of Wolff and Shaffer, the Examiner is utterly silent.

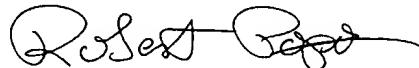
Thus, in view of the above, Appellants respectfully request the Board to review the claims against the prior art taking into account all claims limitations including the preamble, and to overturn the Examiner's rejection of the claims on appeal and pass the case to allowance.

CONCLUSION

For the many reasons advanced above, Appellants respectfully contend that each claim is patentable and reversal of all rejections and allowance of the case is respectfully solicited.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

Respectfully submitted,



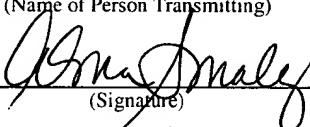
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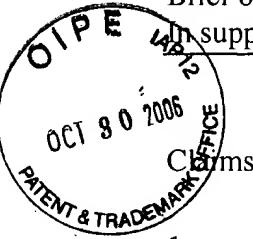
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Attachments



1. A hard-copy output device, comprising:

a memory for storing location data;

a network interface; and

an HTTP location server for receiving and storing location data in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory.

2. A device according to claim 1, wherein the location server comprises a wireless interface for receiving the location data .

3. A hard-copy output device, comprising:

a wireless interface for receiving data;

a memory;

a network interface; and

a location server for receiving location data via the wireless interface and storing it in the memory and for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory.

4. A device according to claim 2, wherein the location server is operative to cause the form of the received location data to be converted from a first form to a second form prior to storage in said memory, one of the first and second forms being a semantic location form and the other a form based on geographic coordinates.

5. A device according to claim 4, wherein the location server effects said conversion by using a conversion service which it contacts over the network.

6. A device according to claim 1, wherein the location server is operative to cause the form of the stored location information to be converted from a first form to a second form for output in response to a said client request, one of the first and second forms being a semantic location form and the other a form based on geographic coordinates.

7. A device according to claim 6, wherein the location server effects said conversion by using a conversion service which it contacts over the network.

8. A device according to claim 1, wherein the received location data includes a reliability indicator which the location server uses to determine whether or not to overwrite existing location data, if any, held in said memory.

9. A device according to claim 8, wherein the related reliability indicator is stored where the location server decides to store the newly received location data, the location server when determining whether to store newly received location data, taking account of the relative reliabilities of the stored and newly received information as indicated by their related reliability indicators.

10. A device according to claim 9, wherein said reliability indicator indicates whether the location data has been received directly from an entity with a primary source of location data or from an entity which itself received the data from another entity, the location server preferentially storing or retaining location data received directly from an entity with a primary source of location data.

11. A hard-copy output device, comprising:

 a memory; and

 a location server for receiving location data and storing it in said memory and for accessing the stored location data and outputting it, the location server being operative to convert the location data it handles between a first form and a second form, one of the first and second forms being a semantic location form and the other a form based on geographic coordinates.

12. A device according to claim 11, wherein the location server receives location data in the form of geographic coordinates and converts the location data into semantic form.

13. A device according to claim 11, wherein the location server receives location data in semantic form and converts the location data into geographic coordinates.

14. A device according to claim 12, wherein the location server effects said conversion by using a remote conversion service.

15. A device according to claim 11, wherein the stored location data is in the form of geographic coordinates and the location server converts this location data into semantic form before outputting it.

16. A device according to claim 11, wherein the stored location data is in the form of geographic coordinates and the location server converts this location data into geographic coordinates before outputting it.

17. A device according to claim 15, wherein the location server effects said conversion by using a remote conversion service.

18. A device according to claim 11, further comprising a wireless output interface, the location server being operative to output the location data via the wireless interface at intervals.

19. A device according to claim 11, further comprising a network interface, the location server being operative to output said location data in response to a location request received over the network.

There is no evidence submitted with the present Brief on Appeal.

U. S. Appln. No. 09/881,211
Brief on Appeal dated October 26, 2006
In support of Notice of Appeal submitted May 16, 2006

Related Proceedings Appendix Page C-1

There are no other appeals or interferences related to the present application.